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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FMDM:002US

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Application Number

Filed

10/675,548

September 30, 2003

on September 19, 2006

Signature

First Named Inventor

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Typed or printed
name

MARK B. WILSON

Art Unit

3637

Examiner

Phi Dieu Tran A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number 37,259

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Registration number if acting under 37 CFR 1.34



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September 19, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

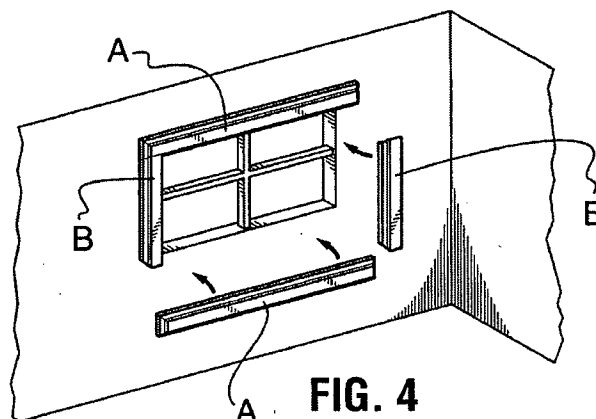
This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

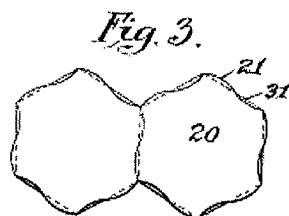
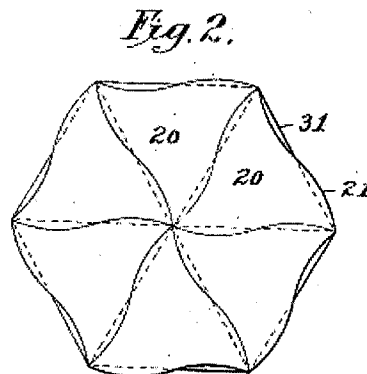
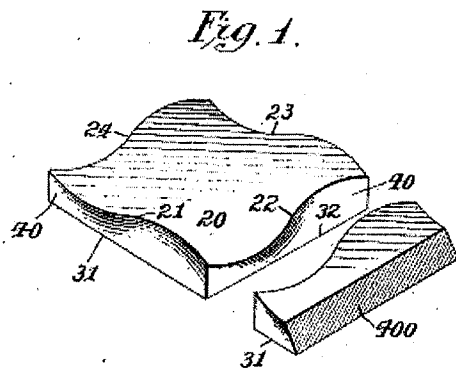
I. The Independent Claims are Not Anticipated by Pugh (U.S. Patent 888,530)

Claim 1 is directed to “[a] casing system” that includes first and second casing pieces which are adapted to cover gaps between framing members of structural openings and vertical walls in buildings. Claim 12 is also directed to “[a] casing system”, and claim 15 concerns a corresponding kit of parts for forming a casing system. FIG. 4 of Applicant’s specification illustrates a non-limiting embodiment of the present invention where first (A) and second (B) casing pieces are used to cover gaps between a window frame and a vertical wall in a building:



A. Pugh fails to disclose Applicant’s claimed “casing system”

Pugh fails to mention or even suggest a casing system—much less Applicant’s casing system that includes first and second casing pieces. Rather, Pugh “relates to **tiles for floors.**” Pugh at page 1, col. 1, line 8. A stated benefit of the tiles is that “a surface composed of these tiles may be worn down to a thin layer without unlocking the vertical bond between the adjacent tiles.” *Id.* at page 2, col. 1, lines 9-12. This is an apparent advancement over previous floor tiles which “constantly worked loose and caused not only unsightly gaps in the floor design, but also made an open recess which caused persons walking over the tiled surface to trip or fall.” *Id.* at page 1, col. 1, lines 20-25. FIGS. 1-3 are illustrative of the Pugh floor tiles:



In view of the above, it is clear that Pugh fails to anticipate Applicant's claimed "casing system," first and second casing pieces, and a kit of parts forming a "casing system."

B. The Pugh floor tiles are not suitable for use with Applicant's casing system

In an effort to overcome the deficiencies of Pugh, the Examiner takes the position that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." Action at page 5. From this, the Examiner argues that the Pugh floor tiles are "capable of performing the intended use." *Id.* This statement is incorrect for at least two reasons. First, the independent claims indisputably claim "[a] casing system" or "[a] kit of parts forming a casing system" that include first and second casing pieces. Stated another way, the claimed "casing system", "kit", and "casing piece[s]" are structural limitations and **not** intended use limitations. In fact, Applicant's specification confirms this by explaining "casings" are commonly used "to cover the gaps between the framework of structural openings and installed units" such as "doors, windows, passageways and recessed areas for bookcases, shelves, niches and the like." Specification at page 2, lines 4-23.

Second, the Examiner fails to provide any arguments—much less **any** supporting evidence—that the Pugh floor tiles could be used as casing pieces in a casing system. This alone dooms the anticipation rejection. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (“...the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); *see also In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000) (findings of fact must be supported by “substantial evidence”).

By contrast, Applicant has provided detailed explanations confirming that the Pugh floor tiles are not suitable for use in Applicant’s claimed casing system. For instance, a person of ordinary skill in the art would not be motivated to use the Pugh floor tiles as casing pieces to cover gaps between framing members of structural openings and vertical walls in buildings for several reasons. First, floor tiles are relatively thin with large flat-surface dimensions that are not suitable or amenable for use as casings on vertical walls. Second, both Pugh and the Examiner fail to disclose how to modify the Pugh floor tiles to use them as casing pieces to cover a gap between a framing member and a vertical wall of a building. Finally, the installation of floor tiles to cover gaps between window or door frames and vertical structural walls would require several tiles which would require considerable skill and time for installation.

Therefore, the Examiner’s position that the Pugh floor tiles “are capable of performing the intended use” is supported by no evidence and is, in any event, incorrect.

C. The Examiner incorrectly disregards the claimed “adapted to...” language

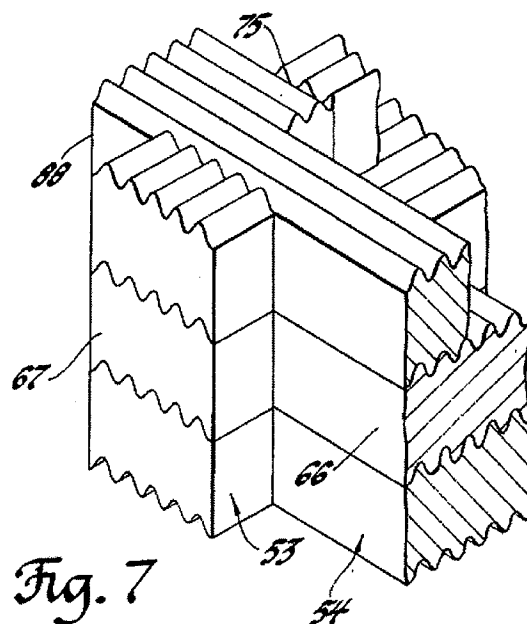
The independent claims describe “casing piece[s]” or “casing system[s]” as being “adapted to cover gaps between framing members of structural opening and vertical walls in buildings.” The Examiner summarily dismisses this claimed element by noting “the added language does not add any claimed structural limitation to the claims.” Action at page 5.

The Examiner's action is improper. For instance, it is well settled that functional language in claims is entirely appropriate and entitled to patentable weight. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1970) ("In our view, there is nothing intrinsically wrong with the use of [functional language] in drafting patent claims."); *see also In re Venezia*, 530 F.2d 956, 959 (CCPA 1976) (holding that a claim reciting the language "may be slideably positioned" was definite and explaining that the language "**limits the structure** of the housing to those configurations which allow for the completed connector assembly desired") (emphasis added).

It is indisputable that Pugh fails to disclose a casing system that is "adapted to cover gaps between framing members of structural opening and vertical walls in buildings" (see above). Therefore, the present anticipation rejection cannot be maintained.

II. Independent Claim 1 Is Not Anticipated by Gascho (U.S. Patent 4,787,185)

Gascho also fails to anticipate the claimed invention. This reference fails to mention or suggest a casing system including first and second casing pieces. Rather, Gascho "relates to unique **log structures**" and corresponding stackable logs. Gascho at col. 1, lines 31-34. The logs are configured for horizontal stacking to make a vertical wall. FIG. 7 is illustrative:



Further, the Gascho logs are not suitable for use in a casing system to cover gaps between framing members of structural openings and vertical walls in buildings for several reasons. First, the logs are of considerable heft as they are used to build log cabin walls which renders them unsuitable for use as casing pieces to cover gaps. Second, the function of the aligned ripples in the top and bottom surfaces of the logs are not decorative, but rather, they serve to provide a very tight interlocking fit between stacked logs (col. 4, lines 8-9).

III. Dependent Claim 16 Is Not Obvious Over Pugh

Claim 16 is not obvious over Pugh for the reasons stated above. Applicant also notes that Pugh is non-analogous art. *See* MPEP § 2141.01(a) (“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem, with which the inventor was concerned.”) (internal quotations and citations omitted). Pugh is not in Applicant’s field of endeavor (*i.e.*, casing systems) as it is concerned with floor tiles. Pugh is not reasonably pertinent to solving the particular problem with which Applicant was concerned (*i.e.*, to cover gaps between framing members of structural openings and vertical walls in buildings). Rather, Pugh is concerned with problems associated with floor tiles that cause “unsightly gaps in the floor design” which also creates “an open recess which cause[s] persons walking over the tiled surface to trip or fall.” Pugh at page 1, col. 1, lines 20-25.

Therefore, the obviousness rejection should be withdrawn.